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Yusuke Ninomiya

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Arguments

The amendments to the claims will not be entered because the scope of the claims is changed; new issues are raised which would require a further search and/or consideration. Specifically, requiring the resin fine particles to be crosslinked acrylic resin fine particles changes the scope.

While arguments to the not entered amendments will not be addressed below, applicant's arguments pertaining to the finally rejected claims will be discussed for further clarification.

A) Applicant's argument that Retzlaff et al. do not disclose the size and amount of particles of the claimed invention is not persuasive. As set forth in the previous Office Action, Retzlaff et al. teaches a particle size of 2-15 microns (para. 17), which overlaps the claimed range, in an amount of 10-25 weight percent (para. 21).

B) Applicant's argument that Retzlaff et al. and Hunakoshi et al. are not concerned with the applicant's particular problem, cissing-preventing properties, is not persuasive. As noted by the Court in KSR, prior art that solves a problem which is different from that which the applicant was trying to solve, may be considered for the purposes of 35 U.S.C. 103. (See MPEP 2141 II. A. 2). Further, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Retzlaff et al. and Hunakoshi et al. are analogous art since they are both concerned with the same

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field of endeavor, namely cationic electrodeposition compositions with epoxy resins and resin fine particles.

C) Applicant's argument that the particles of Hunakoshi et al. are smaller than the instantly claimed invention is not persuasive. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Retzlaff et al. teaches the size of the particles. Hunakoshi et al. is relied on to show that adding a blocked polyisocyanate crosslinker to a similar composition is known in the prior art. Even though neither reference alone teaches all of the required limitations, in combination all limitations are known in the prior art.

D) Applicant's argument that Retzlaff et al. and Hunakoshi et al. do not disclose an improvement in the "cissing-preventing property" is not persuasive. This limitation is not claimed. Further if it were claimed, it would be the Office's position that since all the claimed components are present, this property would be implicit to the composition of as rendered obvious by the rejection set forth in the previous Office Action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Megan McCulley whose telephone number is (571)270-3292. The examiner can normally be reached on Monday - Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

/M. M./
Examiner, Art Unit 1796